

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte TOM BALAMUCKI and BETH I. KLIMEK

Appeal No. 2005-1347  
Application No. 10/051,821

ON BRIEF

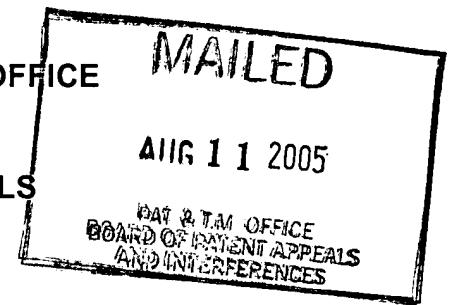
Before MCQUADE, NASE and BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

#### DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-11 and 21, which are all of the claims pending in this application.

#### BACKGROUND

The appellants' invention relates to a transmission assembly having a counterbalance operatively connected to the shift lever to effectively shift the center of mass of the shift lever closer to the pivot to aid in the prevention of shift lever "jump out" which may occur when vibrations caused by potholes or other road conditions cause



the shift lever to move in the direction of disengagement of the gears of the transmission (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief. Claims 1 and 21 have been incorrectly reproduced in the appendix because they incorporate the proposed amendment after final rejection changing the last word in each claim to "axes" from "dimensions." That proposed amendment was not entered (see advisory action mailed November 21, 2003). The last word in each of claims 1 and 21 is "dimensions."

***The Applied Prior Art***

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Bair	5,758,545	Jun. 2, 1998
Onoguchi et al. (Onoguchi) (Japanese Kokai patent application)	HEI 3-134367	Jun. 7, 1991 <sup>1</sup>

The following rejections are before us for review.

Claims 1-11 and 21 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention.

Claims 1-6, 8-11 and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bair.

Claims 1, 7-9 and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Onoguchi.

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<sup>1</sup> We derive our understanding of this reference from the English-language translation obtained by the USPTO, a copy of which was mailed to the appellants November 21, 2003.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (mailed September 16, 2003) answer (mailed March 18, 2004) for the examiner's complete reasoning in support of the rejections and to the brief (filed February 19, 2004) and reply brief (filed May 19, 2004) for the appellants' arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

#### ***The indefiniteness rejection***

We cannot sustain the rejection of claims 1-11 and 21 under 35 U.S.C. § 112, second paragraph, as being indefinite. The examiner makes much of the fact that the appellants use the term "axis" and "axes" in their specification and do not use the term "dimensions," exclusive of the claims<sup>2</sup>. While this may indeed be an appropriate basis for an objection to the specification under 37 CFR § 1.75(d)(1) as failing to provide proper antecedent basis for the claimed subject matter, we find nothing in this which renders the claims indefinite. One of ordinary skill in the art would understand the term "dimensions," within the context of the claimed invention, to refer to the dimensions of three-dimensional space, whether those dimensions be expressed in Cartesian, polar

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<sup>2</sup> The term "dimensions" did not appear in the originally-filed claims.

or other coordinates. While it is not clear to us that the terms "axes" and "dimensions" truly differ in scope from one another within the context of the invention, we also note that merely that a claim is broad does not mean that it is indefinite. See In re Johnson, 558 F.2d 1008, 1016 n.17, 194 USPQ 187, 194 n.17 (CCPA 1977); In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971); In re Gardner, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970) and Ex parte Scherberich, 201 USPQ 397, 398 (Bd. App. 1977).

***The anticipation rejection based on Bair***

As perhaps best illustrated in Figure 1, Bair discloses a shift lever assembly comprising shift lever 31 extending downwardly into a shifting mechanism 32 movable about a pivot 34. In order to minimize shift lever-induced jumpout, described in the paragraph bridging columns 2 and 3, a counterweight member comprising a mass 52 is fixedly cantilever-mounted to the shift lever 31 by a mounting means 54 which extends the center of gravity of the resultant shift lever assembly forwardly of the lever pivot axis 34. The mass of the counterweight member 52 and the length of the cantilever mounting means 54 is selected such that the center of gravity of the resulting shift lever assembly 30 will be such that the torque resulting from vertical accelerations will tend to counteract torque resulting from pivotal accelerations (column 5, lines 1-9).

Despite the appellants' argument that Bair's counterweight moves the center of gravity of the shift lever assembly in one direction, forward, only, it is quite apparent that the center of gravity must also be moved downwardly toward the pivot 34, given the

vertical proximity of the counterweight member 52 to the pivot 34 and the vertical spacing of the counterweight member 52 from the center of gravity cg illustrated in Figure 2. This is akin to the schematic of the appellants' invention illustrated in Figure 5 of the present application. As to the movement of the center of gravity in two horizontal dimensions, there is no indication that the location of the center of gravity of the counterweight member 52 in the dimension into and out of the paper, as illustrated in Figure 1, differs at all from that of the shift lever 31. Nevertheless, even assuming that the centers of gravity of these two items, as well as the resultant center of gravity of the shift lever assembly 30, are all located in the plane of the paper as illustrated in Figure 1, in a Cartesian coordinate system wherein neither of the horizontal axes is in the plane of the paper or normal to the plane of the paper, the three centers of gravity are all offset from one another in two horizontal dimensions, with the resultant center of gravity between the other two.

In light of the above, the appellants' arguments that the location of the resultant center of mass is not different from the center of mass of the shift lever in three dimensions and in two horizontal dimensions, as called for in claims 1 and 21, are not well taken. We shall thus sustain the rejection of these claims, as well as claims 2, 3 and 8-11 which appellants have elected not to argue separately from claim 1, as being anticipated by Bair.

With regard to claim 4, it is clear from the location of the counterweight member 52 in Figure 1 and the center of gravity cg of the shift lever 31 in Figure 2 that the

counterweight member 52 is at a different vertical location than the center of mass of the shift lever 31. Consequently, the resultant or total center of mass of the shift lever assembly is located at a third location between those of the shift lever 31 and the counterweight member 52. The rejection of claim 4 as being anticipated by Bair is sustained.

It is likewise true that the total center of mass is vertically closer to the pivot 34 than the center of mass  $cg$  of the shift lever 31. The rejection of claim 5 as being anticipated by Bair is thus also sustained.

The appellants' argument on page 9 of the brief with respect to claim 6 is not well taken for the reasons discussed above. It follows that we shall also sustain the rejection of claim 6 as being anticipated by Bair.

***The anticipation rejection based on Onoguchi***

The appellants' arguments on pages 10-12 of the brief and pages 6 and 7 of the reply brief focus primarily on the examiner's reliance on an untranslated foreign reference. This deficiency was remedied on December 15, 2004 by the examiner by the provision of an English-language translation of the Onoguchi reference, a copy of which was mailed to the appellants' counsel on the same date. Our review of that translation reveals that it supports the examiner's position that the item 18 referred to by the examiner as a "counterbalance mass" on page 5 of the final rejection is in fact a mass. As illustrated in Figures 1 and 2 of Onoguchi, the mass 18 is located at a location different from that of the center of mass of the shift lever 16 both vertically and

horizontally and is operatively connected to the shift lever via elastic bracket 19, holder rubber 14 and support part 11a. Thus, for the same reasons discussed above with respect to Bair, the location of the resultant center of mass, taking into account the mass 18, of the shift lever assembly differs in three dimensions, a vertical dimension and two horizontal dimensions, from that of the shift lever 16. Accordingly, the rejection of claims 1 and 21, as well as claims 8 and 9 which the appellants have not argued separately from claim 1, as being anticipated by Onoguchi is sustained.

The appellants' argument with respect to claim 7, namely, that the figures of Onoguchi do not make evident that the element 14 is a resilient connection between the counterbalance mass and the shift lever reducing vibration of the shift lever during vehicle operation (brief, page 11), finds full response in the translation provided by the examiner. Specifically, the elements 14 and 19, through which the mass 18 is connected to the support part 11a and hence to the shift lever 16, are identified on page 4 of the translation as a holder rubber 14 and an elastic deformable bracket 19. The translation also informs us, on page 4, that

[t]he elasticity of the said bracket (19) is selected appropriately so that the bracket exhibits little elasticity when the transmitted vibration is at the low end of the spectrum, and acts like a spring at the high frequency end of the spectrum. As a result, in the low frequency region of the vibration that is transmitted from power unit (12), such as in the region where the vibration of the shift lever becomes a problem, mass (18) simply acts as a damper on support rod (11). Also, in the high frequency region of the vibration transmitted from power unit (12), such as in the region where gear noise occurs, mass (18) and bracket (19) act as a dynamic damper.

In light of the above, the translation provided by the examiner fully responds to the argument of the appellants. Accordingly, the rejection of claim 7 as being anticipated by Onoguchi is sustained.

CONCLUSION

To summarize, the rejection of claims 1-11 and 21 under 35 U.S.C. § 112, second paragraph, is reversed and the rejections of claims 1-11 and 21 under 35 U.S.C. § 102(b) are affirmed. As a rejection of each of the claims on appeal has been sustained, the examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

  
John P. McQuade

JOHN P. MCQUAДЕ  
Administrative Patent Judge



JEFFREY V. NASE

JEFFREY V. NASE  
Administrative Patent Judge

  
JENNIFER D. BAHR  
Administrative Patent Judge

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